

ESTTA Tracking number: **ESTTA524504**

Filing date: **03/04/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	OUT FIT 7 LIMITED OUT FIT 7 LIMITED
Granted to Date of previous extension	03/30/2013
Address	146 Arch Makariou III Alpha Tower, 4th floor Limassol, 3507 CYPRUS
Party who filed Extension of time to oppose	OUT FIT 7 LIMITED
Relationship to party who filed Extension of time to oppose	The opposer's name has not changes, the opposer is still the legal entity, company OUT FIT 7 LIMITED. The opposer name was listed in the "name" field once we started this procedure and the "company" filed was empty. Because the opposer is a company, we have entered OUT FIT 7 LIMITED also in the "Company field".
Correspondence information	IZA LOGIN DIRECTOR 146 Arch Makariou III Alpha Tower, 4th floor Limassol, 3507 CYPRUS ip@outfit7.com

### Applicant Information

Application No	85368788	Publication date	01/29/2013
Opposition Filing Date	03/04/2013	Opposition Period Ends	03/30/2013
Applicant	Resnicoff, Stanley 510 North Guadalupe Avenue Redondo Beach, CA 90277 UNITED STATES		


### Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Entertainment services, namely, providing a website featuring non-downloadable entertainment videos and motion picture shows; cartoon shows broadcast via Internet; online video clips, namely, providing a website featuring non-downloadable video clips, all the foregoing featuring an animated cartoon character
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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## Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85185074	Application Date	11/24/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TALKING TOM		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use:</p> <p>Entertainment services, namely, providing online computer games for mobile or cellular telephone and other wireless devices; entertainment services, namely, providing online computer games provided via the Internet or other computer network; online gaming services, namely, providing online video games; production of audio, video, and multimedia recordings; entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, related film clips, photographs and other multimedia entertainment materials featuring animated cartoon characters; providing non-downloadable video and audio recordings about animated cartoon characters made within computer games via a web site; entertainment services, namely, providing online computer games and online video games that are accessible and playable via mobile and cellular phones and other wireless devices; entertainment, namely, a continuing entertainment animated cartoon show broadcasted over global and local area computer networks; entertainment services, namely, providing touch and voice driven online computer games for digital mobile devices; providing online electronic games for use on mobile devices; providing news and information in the field of entertainment regarding interactive computer game software, interactive video game software and interactive computer and video games, via electronic, wireless and computer networks; providing online computer and video games accessed and played via electronic, wireless and computer networks; online multiplayer video game tournaments; animation film and video production services</p>		

Attachments	85185074#TMSN.jpeg ( 1 page )( bytes ) O7_Tom the Talking Toilet_opposition.pdf ( 6 pages )(279039 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Iza Login/
Name	IZA LOGIN
Date	03/04/2013

USPTO  
Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451 Alexandria, VA 22313-1451

via USPTO page (ESTTA)

**Date: 27 of February 2013**

**Reference:** opposition against Trademark Application number SN 85-368,788 (A) for Mark: “Tom the Talking Toilet” (US Serial Number 85368788)

**Applicant:** Resnicoff, Stanley INDIVIDUAL UNITED STATES 510 North Guadalupe Avenue Redondo Beach CALIFORNIA 90277 (hereinafter referred to as: the opponent)

Dear Sir or Madam,

please find an opposition against Trademark Application for Mark “Tom the Talking Toilet”, application number SN 85-368,788 (A), US Serial Number 85368788 (opposed mark), applied for goods and services for International Class 41 (US Class 100, 101, 107), based on our prior registered mark “Talking Tom, ”US Serial Number: 85185074, registered for services for International Class 41 (US Class 100, 101, 107). Additionally the owner of the prior mark has several other trademark applications for the same mark and the same goods before the USPTO, namely: 85189053, 79111041 and 79110989.

## Relevant law

Trademark Act (TMPE) section 1207.01 (Likelihood of confusion), Section 2(d) clearly states, that if there is **likelihood of confusion** between applicant’s mark and prior mark, that represents grounds for refusal for registration of the applicant mark.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals discussed the factors relevant for determining the likelihood of confusion, saying that the issue of likelihood of confusion typically revolves around **the similarity or dissimilarity of the marks and the relatedness of the goods or services**. In re National Novice Hockey League, Inc., 222 USPQ 638, 640 (TTAB 1984) and in Circuit case of *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979), the court stated the following factors as those usually being the most relevant: the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, the relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use, the similarity or dissimilarity of established (origin of goods), the similarity or dissimilarity of

distribution channels, types of consumer (relevant public), the fame of the prior mark in terms of sales, advertising, and length of use, any other fact probative of the effect of use.

The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with particular goods or services for which they are used. As it will be explained further on, there are various reasons why the registration of opposed mark would establish likelihood of confusion with our prior mark with the average consumer and why hence, the opposed mark cannot be registered.

## COMPARISON ON GOODS AND SERVICES

### Comparison of signs/marks :

Prior mark	Opposed Mark
TALKING TOM	TOM THE TALKING TOILET

In accordance with case law, the points of comparison for a word mark are appearance (visual comparison), sound (aural comparison), meaning (conceptual comparison), and commercial impression (Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), citing In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)).

The number and sequence of its syllables particularly influence the overall aural impression produced by a sign (**aural comparison of marks**). The key elements for determining the overall phonetic impression of a trademark are the syllables and their particular sequence and stress. The assessment of common syllables is particularly important when comparing marks phonetically, as a similar overall phonetic impression will be determined mostly by those common syllables and their identical or similar combination. It is clear, that there are phonetic similarities between prior trademark “TALKING TOM” and opposed trademark “TOM THE TALKING TOILET”. Both trademarks include the word “TOM” and the word “TALKING.” Trademark “TALKING TOM” has ten (10) letters and three (3) syllables and opposed trademark has nineteen (19) letters and six (6) syllables. Considering the fact, that the opposed mark consists of exactly the same words as a prior mark, adding just two words (one being an article adjective), it is evident that both marks have very similar phonetic impact and it does not contribute to dissimilarity of both marks.

Both marks are furthermore **visually very similar**. For word marks, the visual comparison is based on an analysis of the number and sequence of the letters, the number of words and the structure of the signs (e.g. whether word elements are separated or hyphenated). However, the average consumer normally perceives a sign as a whole and does not proceed to analyze its various details. Therefore, small differences in the (number of) letters are often not sufficient to exclude a finding of visual similarity, particularly when the signs have a common structure. There is a strong visual similarity between the “TALKING TOM” and “TOM THE TALKING TOILET.” The opposed mark includes both words of a prior mark TALKING TOM, just the order of the words is opposite. The element Tom, being the element with the highest attention as a Name, forms the dominant part in the perception of the trademarks by the relevant public. This results in a clear visual similarity.

Both marks are also very **conceptually similar**. Two signs are identical or similar conceptually when they are perceived as having the same or analogous semantic content. The semantic content of a mark is what it means, what it evokes or, when it is an image or shape, what it represents. In this text the expressions ‘semantic content’ and ‘concept’ will be used indiscriminately. If a mark consists of various elements (for example, a word and a figurative element) the concept of each of the elements must be defined. As a rule, the relevant goods and services do not influence the conceptual comparison. However, if a term has many meanings, one of which is of particular significance to the relevant goods and services, the conceptual comparison may focus on this meaning. Both marks include the word “TOM” or the word which derives from it in their names. The word “TOM” has a very limited meaning, hence it is a male name, in some but rare cases it can be surname, abbreviation. The same can be said for the word “Talking” which can mean only that someone is uttering words or is able to talk and it basically has no other meaning. It is an adjective that further defines the characteristics of the name. Consequently, the meaning of these two marks is conceptually very similar, and can hardly revoke more meanings or associations with the public.

**Furthermore, when comparing marks with more words, one must determine whether there is a portion of the word mark that is dominant in terms of creating a commercial impression. Accordingly, if two marks for related goods or services share the same dominant feature and the marks, when viewed in their entireties, create similar overall commercial impressions, then confusion is likely (In re J.M. Originals Inc., 6 USPQ2d 1393 (TTAB 1987) (JM ORIGINALS (with "ORIGINALS" disclaimed). Compared marks both have the word “Tom” that may be clearly considered as the dominant one, as well as “Talking” therefore they create similar overall commercial impression. Furthermore word “the” is just the definite article and it therefore by itself does not have any “higher” meaning and is connected to the work “tom” and “talking” and the word “toilet” is just added at the end and does not influence on the meaning of the word connection “Talking”, “Tom”. Both marks are for a character named Tom that is able to talk. The work “toilet” in the opposed trademark only defines what type of character the Tom is. Overall impression of both marks is even more similar, considering that both marks actually represent animated characters named Tom, who talks. The fact that the animated character is a cat in the case of a prior mark and a toilet in opposed mark, doesn’t influence on their overall impression. Furthermore it is considered, that even if the product or the service between marks differ (in this case the conceptuality of the word and the services are identical), the strongest meaning (grater weight) is always given to the word, because it is the word that the purchaser would use to refer to goods and services (In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987)).**

**Furthermore, it is believed, that the similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar (In re Lamson Oil Co., 6 USPQ2d 1041, 1043 (TTAB 1987)). Compared marks are similar on all level, hence they clearly constitutes a likelihood of confusion between both marks.**

#### Comparison of the services

Opposed mark is applied for 41 class of Nice Classification, namely for : *“entertainment services, namely providing a website featuring non-downloadable entertainment videos and motion picture*

*shows; cartoon shows broadcast via Internet; online video clips, namely, providing a website featuring non-downloadable video clips, all the foregoing featuring an animated cartoon character, Standard character Mark, Serial Number 85368788.”*

The prior mark is also registered for 41 class of Nice Classification for: “Entertainment services, namely, providing online computer games for mobile or cellular telephone and other wireless devices; entertainment services, namely, providing online computer games provided via the Internet or other computer network; online gaming services, namely, providing online video games; production of audio, video, and multimedia recordings; entertainment services, namely, providing a web site featuring non-downloadable musical performances, musical videos, related film clips, photographs and other multimedia entertainment materials featuring animated cartoon characters; providing non-downloadable video and audio recordings about animated cartoon characters made within computer games via a web site; entertainment services, namely, providing online computer games and online video games that are accessible and playable via mobile and cellular phones and other wireless devices; entertainment, namely, a continuing entertainment animated cartoon show broadcasted over global and local area computer networks; entertainment services, namely, providing touch and voice driven online computer games for digital mobile devices; providing online electronic games for use on mobile devices; providing news and information in the field of entertainment regarding interactive computer game software, interactive video game software and interactive computer and video games, via electronic, wireless and computer networks; providing online computer and video games accessed and played via electronic, wireless and computer networks; online multiplayer video game tournaments; animation film and video production services.”

Based on above, it is seen, that the registered services of opposed mark is completely identical with the services registered by prior mark. That is also one of the important criteria, that has to be considered when evaluating likelihood of confusion of both marks, which is in the given case, therefore very high.

The consumer of the products sold under the trademarks TALKING TOM and TOM THE TALKING TOILETS is the user of the services. The attention that will be given to the usage of the different services by this consumer will not be higher than average. That is even more enhanced, considering that the **relevant public** with both trademarks is the same. Relevant public of prior mark is user of its mobile application who buys goods and uses its services specifically for its animated character, which are mostly children and teenagers. That is even more emphasized when it comes to the products deviating from class 41 of Nice classification (services connected with cartons, video games). The relevant public in opposed trademark regarding class 41 of Nice classification are also children and teenagers, hence the same services are in consideration. Considering the age of the relevant public, their ability to distinguish between services is reduced and the degree of relating potential services of opposed mark with the service of prior mark are even more likely, which only increases considering that both marks represent talking animated characters named Tom.

The opposed trademark would be registered in the **territory** of US which, which means that the territory and **distribution channels** would be the same as well as **points of sale**. Main distribution channel of a prior mark and its owner’s mobile applications and services connected to it, are



virtual stores, where mobile applications are being sold or being available for download for no charge, for other goods and services the main point of sales are on line stores available at <http://talkingfriends.com>, <http://talkingfriends.eu> and <http://tfsuperstar.com>. One of the most important distribution channel for the prior marks' recognition is also YouTube, where many Talking Tom videos can be found (e.g. [http://www.youtube.com/results?search\\_query=talking+tom&page=1](http://www.youtube.com/results?search_query=talking+tom&page=1) ). It is also an existing distribution channel for opposed mark, hence we can also find videos of "Tom the talking Toilet" (for example: <http://www.youtube.com/watch?v=eOEzIVvKTII>). The opponent here also pinpoints, that at the end of the "Tom the Talking Toilet" video, where similar videos of the one just watches appear on the screen, only the videos of "Talking Tom" emerge, which is one more evidence of similarity of these two marks and likelihood of confusion. Distribution channels of a prior mark are in English, as well as are opposed mark, which is another similarity concerning the origin of service, that has to be taken into consideration. It is also important to consider how broad are the specialized range of goods and services of prior mark, hence it is believed that if a company offers a very narrow, specialized range of goods and services there is less likelihood that consumers would expect that company to produce or provide different goods or services. Alternatively, if a company (owner of a mark in question) offers a very wide range of goods or services, consumers may associate almost any goods or services with that company. In the group of talking friends there are number of trademarks for logos, words and figurative mark: Talking Ginger, Talking Pierre, Talking Babby Hippo, Talking Larry, Talking John, Talking Rex, Talking Angela, Talking Harry, Talking Santa, Talking Gina, Talking Tom, Talking Ben, Talking Lila. These trademarks are registered for many different classes of goods and services of Nice Classification, which result in various different products and services of the trademarks. For example, "Talking Tom" alone, registered in the US (US Serial number; 79111041) is registered for 14 different International classes (3, 9, 11, 14, 16, 18, 20, 21, 24, 25, 27, 28, 41, 42), which means that there are a high number of various products and different services on the market relating to that mark. The customers of Talking Friends product therefore expect that a company offers a various number of different goods and services and associates various products to Talking Friends trademarks. Due to the fact, there obviously is a wide range of goods and services connected to prior mark, it is highly likely that a consumer would assume that the services of opposed mark are actually the services of a prior mark and would not be able to clearly separate them.

In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) the court stated, that the issue is not whether or not the actual goods are likely to be confused, rather, whether there is a likelihood of confusion as the sources of the goods. Based on stated above, it is evident, that an average consumer would assume, that the services provided by opposed mark derives from the same group of services as a prior mark.

The **fame of the prior mark in terms of sales, advertising, and length of use is also** one of the important criteria regarding similarity of the nature of goods and services (n re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Owner of a prior mark's downloadable applications "Talking Friends" has more than 720 million downloads worldwide. In USA the number of users is 52 million, monthly active users being over 5, 7 million, making the Owner of a prior mark the fastest growing application developer in the world. Talking Friends cartoons have more than 95,4 million views on YouTube and more than 89,8 million views on Disney.com Talking Friends is family of trademarks and average user of mobile application



associate the word “TALKING” to opponent applications. In the light of the extremely favorable acceptance of the Talking Friends characters by the consuming public, it is evident that a prior mark acquired distinctiveness as a source indicator. **Consequently, the word Talking Tom as the dominant part of prior mark is known by relevant portion of the relevant public due to high number of users of its Talking Friends applications in the relevant territory.** Because the prior mark is well known, the average consumer will harder distinguish between the both marks and it will associate all the services containing the word “Talking Tom” with the prior mark. This will further contribute to likelihood of confusion of both mark and it is important to stress, that just the fame of registered mark alone is a significant factor in finding likelihood of confusion (In Tiffany & Broadway v. Commissioner, 167 F. Supp.2d 949 (S.D. Tex. 2001)).

**The opponent emphasizes that the relevant test is likelihood of confusion, not actual confusion and it is not necessary to show actual confusion to establish likelihood of confusion (Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990)).** Likelihood of confusion is clearly established, hence all the relevant characteristics of opposed trademark are not distinctive enough and are not able to identify the goods and services as coming from particular undertaking. There is a high degree of similarity between the marks, due to the fact that the services in question are identical, the distribution channels are the same, language used is the same, territory, the same relevant public, broad range of services and product connected with prior mark “Talking Tom”.

Based on the facts stated above, we kindly request you to refuse the application trademark “TOM THE TALKING TOILET” based on a ground that there is likelihood of confusion with prior mark and we furthermore request to reimbursement all of our expenses, arising from this proceeding.

Your sincerely,

Iza Login, Director

